

PTO/SB/21 (09-04)

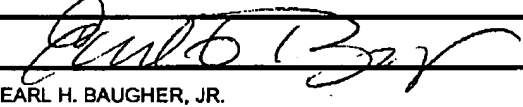
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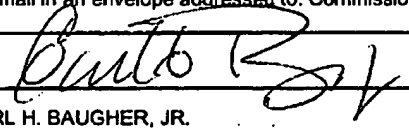
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/715,430	
	Filing Date	11/19/2003	
	First Named Inventor	MCINERNEY	
	Art Unit	3873	
	Examiner Name	G. SPAHN	
Total Number of Pages In This Submission	4	Attorney Docket Number	COE-668

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Attorney Docket No.
COE-566

PATENT APPLICATION
Serial No. 10/715,430

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re PATENT APPLICATION of

McInerney et al.

5 Serial No. 10/715,430

Examiner: G. Spahn

Filed: 11/19/2003

Group Art Unit: 3673

For: EMBEDDED BARRIER TO FLUID FLOW

ELECTION/RESTRICTION UNDER 35 USC §121

10

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

15

Sir:

In response to the Office Action dated June 15, 2005, hereinafter "Office Action", Applicants elect, *with traverse*, Examiner's Group I, i.e., Claims 1 through 15, where claim 1 is independent and Claims 2-15 are claims depending from Claim 1 or depending from claims dependent on Claim 1. Please reconsider the election/restriction with regard to remaining Claims 16-35 as divided by Examiner into Group II having apparatus Claims 16-35. Examiner's election/restriction under 35 USC §121 will now be reviewed in greater detail.

In para. 2 of the office action, Examiner states:

25

The inventions are distinct, each from the other because:

30

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product, or (2) that the product as claimed can be made by another and materially different process. (MPEP-§ 806.05(f)). In the instant case the claimed configuration can be made by another and materially different process such as one in which the adhesive is applied to the non-porous material prior to placing the non-porous material upon the first section.

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In para. 3 of the office action, Examiner states:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Applicants respectfully disagree. Using the process of Claims 1-15, one can use only the apparatus of Claims 16-35 to yield the desired result, i.e., a structure that does not transfer moisture in an undesirable direction.

In para. 3 of the office action, *Election/Restrictions – Election of Species Requirement*,

5 Examiner states:

This application contains claims directed to four groups of species of the claimed invention from which Applicants must elect. The four groups of species from which Applicants must elect are as follow:

10 Species I (as directed to plates/foils): species of one plate/foil; species of two plate/foil; and species of three plate/foil.

15 Species II (as directed to material for barrier – see claims 2 and 17): metal; metal alloy; steel alloy; stainless steel; composite material; composite material containing at least some metal; and combinations thereof.

Species III (as directed to joining means): tack welding; soldering; gluing; heating; applying pressure; and combinations thereof.

20 Species IV: Fig. 4; and Fig. 5.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species from each of the four groups of species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
25 *Currently, independent claims 1 and 16 appear to be generic.*

Applicants elect as to Species 1, species of one plate/foil.

Applicants elect as to Species II, species of metal.

30

Applicants elect as to Species III, species of applying pressure.

Applicants elect as to Species 1V, species of Fig. 5.

35 Under MPEP §808.02, the Examiner must establish that examining all the inventions in a single application will create a serious burden on the USPTO. Examining the claimed invention, Claims 1–35, in a single application will not create a serious burden on the USPTO. The same research suffices for both the method claimed and the apparatus. Further, an

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applicant has a statutory right to claim an invention as he/she sees fit. *In re Weber*, 580 F.2d at 458, 198 U.S.P.Q at 332.

5

Respectfully Submitted,

By: 

10 U.S. Army Corps of Engineers
Humphreys Engineer Center
CEHEC-OC (Kingman Bldg.)
7701 Telegraph Rd.
Alexandria, VA 22315-3860
505 342-3360

EARL H. BAUGHER, JR
Attorney for Applicants
Registration No. 40,905